

II. Remarks

A. Status of the Claims

Claims 1-16 are currently pending. No claims amendments have been made.

B. Claim Rejections under 35 U.S.C. § 103

1. Potter in view of Charette

In the Office Action, claims 1, 4-7 and 12-16 were rejected as being unpatentable over U.S. Patent No. 5,787,402 to Potter in view of U.S. Patent Application Publication No. 2002/0069114 to Charette.

This rejection is respectfully traversed. Applicants submit that the combined teachings of Potter and Charette fail to render obvious the computer implemented methods for pricing a trade, as presently claimed. The Examiner is reminded that pursuant to MPEP, 8th Ed., 7th Rev. § 2142, to establish a prima facie case of obviousness, and thus sustain the rejection of a claim under 35 U.S.C. § 103(a), there must be a clear articulation of the reasons why Applicants' claimed invention would have been obvious. *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398 (2007).

The Supreme Court in *KSR* has further noted that an analysis supporting a rejection under 35 U.S.C. § 103(a) should be made explicit. Therefore, it is clear that an obviousness rejection "cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *In re Kahn*, 441 F.3d 977 (Fed. Cir. 2006). Moreover, "[t]o support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." MPEP, 8th Ed. 7th Rev. § 706.02(j).

Applicants submit that, as admitted by the Examiner, "Potter does not specifically teach said structure is capable of submitting the trade data via email or an email attachment". *Office Action* at page 3. To cure this deficiency, the Examiner alleges that "this matter is taught by Charette as transmitting trade data via emails". *Id.* However, Applicants respectfully disagree

with the Examiner's position, and submit that (i) Potter and Charette are improperly combinable; and (ii) this limitation is not taught by Charette.

Applicants respectfully submit that Potter and Charette are improperly combinable. Potter is directed to "[a] method and system for performing financial transaction involving foreign currencies deals in virtually all trading currencies" (*Potter*, Abstract), whereas Charette is directed to "[a] method and system for placing a purchase order with a product trader for a product over a communication network [by] accessing an information site on a shopping server using a shopping client and downloading program code for executing a shopping cart to the shopping client" (*Charette*, Abstract). Applicants submit that performing an online trade in a foreign money market is a different field of endeavor than using a downloadable shopping cart to purchase a product in e-commerce.

Furthermore, the Examiner cites Charette solely for its brief discussion of the e-mail element. However, the Examiner is reminded that one "...cannot pick and choose among the individual elements of assorted prior art references to recreate the claimed invention." *SmithKline Diagnostics, Inc. v. Helena Laboratories Corporation*, 859 F.2d 878,887 (Fed. Cir. 1988).

Even assuming *arguendo* that Potter and Charette were properly combinable, the combination of Potter and Charette still fails to teach the claimed limitations. Applicants respectfully point out that, as recited in the present claims, the structure of the present invention is capable of (i) receiving trade data and (ii) transmitting the trade data to a pricing system via email or an email attachment. Thus, the structure is capable of both receiving information, and transmitting the information directly to the pricing system. In the Charette system, one of the benefits is that the server's only function is to be capable of downloading the shopping cart to the client. "Thus, the functionality required of the server is reduced to simply requiring the ability to download code." *Charette* at paragraph [0005]. The e-mail capability to the Charette system is a separate function, unrelated to the shopping server. "Thus, the e-mail need not be directed to the product server. The e-mail will be handled by the user's ISP (Internet Service Provider) in a conventional manner key routed to the mail server used by the product trader." *Id.* at paragraph [0010]. In addition, not only does Charette fail to describe a structure that can both receive information and transmit the information via e-mail, Applicants point out that the e-mail function

of Charette is used for placing product orders by a shopper, not for sending trade data to a pricing system, as presently claimed.

Accordingly, Applicants submit that Charette fails to cure the deficiencies of Potter and respectfully request that the rejection under 35 U.S.C. § 103(a) be removed.

2. Potter in view of Charette and Finebaum

In the Office Action, claims 2-3 and 8-11 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Potter in view of Charette and further in view of U.S. Application Publication No. 2002/0156719 to Finebaum.

This rejection is respectfully traversed. Applicants again submit that the references are improperly combinable. Finebaum, similar to Potter, is directed to “[a]n Internet based real-time system for broadcasting quotes, usually bid and ask prices, for high-yield corporate bonds to buyers and sellers” (*Finebaum*, Abstract). Thus, Finebaum is not related to e-commerce and is therefore improperly combinable with Charette.

Even assuming *arguendo* that the references were properly combinable, Finebaum fails to cure the deficiencies of Potter and Charette, as Finebaum fails to obviate the limitation of a structure capable of (i) receiving trade data and (ii) transmitting the trade data to a pricing system via email or an email attachment.

Accordingly, Applicants respectfully request that the rejection under 35 U.S.C. § 103(a) be removed.

III. Conclusion

In view of the arguments presented, it is believed that all claims are in condition for allowance. If the Examiner believes that issues may be resolved by a telephone interview, the Examiner is invited to telephone the undersigned at (973)597-6162. The undersigned also may be contacted via email at epietrowski@lowenstein.com. All correspondence should be directed to our address listed below.

AUTHORIZATION

The Commissioner is hereby authorized to charge any fees that may be required, or credit any overpayment, to Deposit Account No. 50-1358.

Respectfully submitted,
Lowenstein Sandler PC

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